

**REMARKS**

This is a full and timely response to the Final Office Action mailed on November 6, 2003. Reexamination and reconsideration in light of the above amendments and the following remarks are courteously requested.

Claims 1 to 8 and 10 to 114 remain in this application with claim 9 canceled, claims 19 to 114 withdrawn from further consideration as drawn to non-elected inventions, and claims 1 to 8 and 10 to 18 examined on their merits. Claim 17 is allowed, and thus retained without amendment. A listing of all pending claims is provided for the convenience of the Examiner and the Applicant's attorney. The non-elected claims are expected to be made the subject of one or more divisional applications so that they can be canceled from this application to place the case in condition for allowance, if all other issues are overcome.

This amendment under Rule 116 either places this case in condition for allowance, or in a better form for appeal by eliminating pending issues, reducing the number of claims pending for consideration on their merits, and overcoming rejections by a submission of certified translations of priority documents, as more fully explained in these remarks.

Rejections of Claims 10 to 16 and 18

Claim 10 had been rejected as being anticipated under 35 USC 102(e) as anticipated by Shimizu, Patent Publication No. 2002/0027715 (Ref. C, first action). Shimizu has a publication date of March 7, 2002, and an actual filing date of April 10, 2001. This subject application has an actual filing date of April 26, 2001, but claims priority on the basis of four (4) Japanese applications respectively filed between April 27, 2000 and August 16, 2000, all of which antedate the actual filing date of the Shimizu published application. In Response to Arguments, the Examiner had asserted that the priority could not be relied upon to antedate Shimizu, unless a translation of the priority documents had been made of record.

Accordingly, certified translations of each of the four (4) priority documents accompany this submission. Thus, Shimizu is removed as a reference and a basis for rejection of claims 1, 2, 4, 5, 6, 10, and 18.

Accordingly, because claims 10 to 16 and 18 are not otherwise rejected, and claim 17 is allowed, claims 10 to 18 are allowable. It is noted that claims 11 to 16 were indicated to be allowable over Shimizu for the reasons stated on page 6 of the Final Action. That indication is acknowledged with appreciation.

Rejections of claims 1 to 8

Claims 1, 2, 4, 5, and 6 were rejected as allegedly being anticipated by Rottman. Claims 1, 6, and 7 were rejected as allegedly being anticipated by Scidmore. Claims 1 and 2 are thus canceled without prejudice or disclaimer, thus mooting the rejections of these claims over either Rottman or Scidmore.

Claim 3 was rejected under 35 USC 103 as allegedly being obvious over Rottman in view of the Judicial Notice, now supported by the patent to Lewis, No. 3,598,475. This rejection is flawed in that it does not state a prima facie basis for obviousness; if the Examiner means to rely specifically on Lewis, then a combination rejection should be made and reference to Lewis incorporated in the rejection, together with sufficient arguments based on facts to support a motivation to combine Lewis with Rottman, or otherwise modify Rottman. If the Examiner intends to apply the newly-cited reference, there would be "no excuse for not positively including the reference in the statement of rejection". In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.c (CCPA 1970). See also MPPEP, section 2144.03 (8<sup>th</sup> ed. August 2001).

Thus, a new non-final Action is solicited.

With respect to the merits of the rejection as stated, relying on Rottman alone, a prima facie case of obviousness is not made. The Action admits that Rottmann does not specifically disclose the liquid as an optical oil, as stated in claim 3,

whereas at best Rottmann only discloses a liquid, not an optical oil. The obviousness alleged is found only in the Applicant's disclosure, so that the rejection as stated is founded in impermissible hindsight. Withdrawal of the rejection of claim 3 based on these findings is respectfully requested.

To this end, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. § Innt. 1985). Requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.) cert. denied, 488 U.S. 825 (1988).

Claims 4 to 6 had been rejected as allegedly being anticipated by Rottman (claims 4 to 6) or Scidmore (claims 5 and 6). By this response the dependency of these claims is now changed to claim 3, argued above to be patentable, because their original base claims 1 and 2 are here canceled. Accordingly, the subject matter of claims 4 to 6, now dependent on claim 3, is patentable for at least the same reasons that claim 3 is patentable, and for their limitations as stated. Moreover, their base claims 1 and 2, now canceled, had been rejected as

anticipated by either Rottman or Scidmore; now, however, the rejection of claim 3 at best is under section 103, so that issues are reduced, the number of claims in issue is reduced, and these claims are prima facie in condition for allowance, as contended.

Claims 7 and 8 each present a different issue, and thus a separate response. These claims, previously dependent on claims 5, itself dependent on claim 1, and 8, dependent on claims 6 and 1, have their base claim 1 canceled. Therefore, each of these claims is rewritten to include the subject matter of their base claims and any intervening claims. That is, claim 7 is rewritten to include the subject matter of claims 5 and 1, while claim 8 is revised to include the subject matter of claims 6 and 1. ]

These claims had been rejected as allegedly being unpatentable over Rottman in view of Hawkins for the reasons stated on page 6 of the Final Action. There is an insufficient teaching of any motivation, or impetus to combine the two teachings found in the references themselves, or in the skill in this art. The motivation is thus found in the teachings of the Applicant, prompting a hindsight analysis that prompted the rejection at page 6. An earlier argument about Rottman and Hawkins is incorporated by reference for brevity, and the argument about motivation stated above is herein restated as fully incorporated at this second point in this response. Thus, the rejection is respectfully traversed, and reconsideration of

the findings of fact and the findings about motivation are respectfully solicited.

Conclusion

Claims 1 and 2 are here canceled. Claim 3 is submitted to be allowable; claims 4 to 6 are now dependent on claim 3 rather than claim 1 so that counterarguments available as to claim 3 are applicable to claims 4 to 6; and claims 7 and 8 are each rewritten into independent form and are patentable for the reasons alleged. Claims 10 to 16 and 18 are now each patentable in that Shimizu is removed as an anticipatory reference as to claims 10 and 18. Claim 17 is allowed, while claims 11 to 16 had been indicated to be allowable, independent of any rejection on the basis of Shimizu. Claims 19 to 114 are withdrawn from consideration and will be the subject of one or more divisional applications.

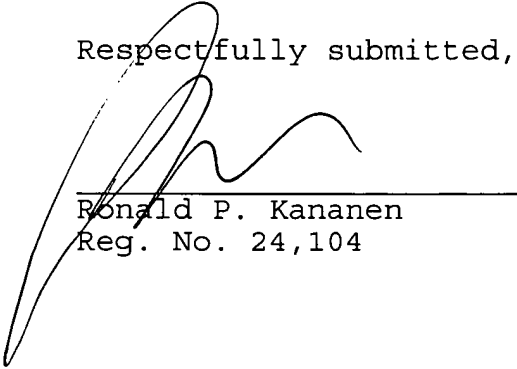
If the Examiner has any suggestions for further moving this prosecution to an effective close, he is invited to telephone the undersigned at the below listed number.

Respectfully submitted,

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